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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,340	06/27/2001	Robert A. Rousseau	ETH-1507	3554

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EXAMINER

GILPIN, CRYSTAL M

ART UNIT PAPER NUMBER

3738

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,340

Applicant(s)

ROUSSEAU, ROBERT A.

Examiner

Crystal M Gilpin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by de la Torre (USPN 5,368,602).

Regarding claim 1, de la Torre teaches of a flexible surgical mesh for implantation in the body (Column 1, Line 65-Column 2, Line 10). De la Torre further teaches that the mesh includes ridges or border members that extend perpendicularly from the mesh surface (Column 3, Lines 63- 68 and Figure 1) and assist in keeping the mesh in a flat or collapsed state (Column 5, Lines 32-41). The transition from a flat state to a collapsed state is inherent in the implantation of the prosthesis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Torre (USPN 5,368,602) in view of Mulhauser et al. (USPN 5,766,246).

Regarding claim 2, de la Torre lacks the teaching of forming the ridge by a thermo-process. Mulhauser et al. Teach of a prosthetic mesh with a ridge or ring (Figure 1, Reference number 14) may be formed by hot or cold forming (Column 4, Lines 60-65), thus comprising a thermo-forming process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of de la Torre to make the ridge by a thermo-forming process so that a portion of the implant would be stiff enough to be properly handled in surgery.

Regarding claim 3, de la Torre teaches that the ridge is "somewhat flexible" (Column 4, Lines 1-6) therefore allowing for some expansion or movement once implanted.

Regarding claim 4, de la Torre teaches that the patch may be used for treating a hernia (Column 5, Lines 63-66).

Regarding claim 5, de la Torre teaches that the mesh is rounded (Column 3, Lines 27-30 and Figure 1).

Regarding claim 6 and 14, de la Torre teaches that there may be more than one semi-rigid members or ridges (Column 4, Lines 35-41 and Figure 3), comprising a plurality.

Regarding claim 15, de la Torre teaches of ridges that extend linearly between the edges of the mesh (Figure 3, Reference numbers 62 and 64, and Column 5, Lines 42-48).

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over de la Torre (USPN 5,368,602) in view of Mulhauser et al. (USPN 5,766,246) in further view of Kugel (USPN 5,634,931).

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Regarding claim 7, both de la Torre and Mulauser et al. teach of a prosthetic mesh, however they both lack the teaching of a mesh with two layers. Kugel teaches of a hernia mesh patch (Entire article, specifically Column 7, Lines 36-60) composed of a top (Figure 5, Reference number 42) and bottom layer (Figure 5, Reference number 44) connected by a ring (Figure 5, Reference number 72). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of de la Torre to connect two mesh layers to provide a pouch used for ease of placement (i.e. with a finger) of the prosthetic.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Torre (USPN 5,368,602) in view of Mulhauser et al. (USPN 5,766,246) in further view of Kugel (USPN 5,634,931) and in further view of Kugel (USPN D416,327).

Regarding claims 8 and 9, both de la Torre and Mulhauser et al. teach of prosthetic meshes with ridges, however they lack the teaching of multiple ridges and different ridge formations. Kugel (USPN D416,327) teaches of two concentric ring shaped ridges. Claim 10 is considered a matter of design choice, based on the disclosure of the specification, and is thus objected to as being obvious. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of de la Torre to have ridges in the shape of concentric rings or other designs to provide sufficient stiffness and strength for the mesh material.

Kugel (USPN D416,327) does not expressly disclose the limitations of claim 10.

However, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the invention of Kugel to include ridges of a different shape because Applicant has not disclosed that the varying shapes of ridges provides an advantage, is used for a particular problem, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a concentric ring shaped ridges because it provides sufficient stiffness and strength to keep the mesh in the preferred flat shape.

Therefore, it would have been an obvious matter of design choice to modify the invention of Kugel to obtain the invention as specified in claim 10.

5. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Torre (USPN 5,368,602) in view of Mulhauser et al. (USPN 5,766,246) in further view of Kugel (USPN D416,327).

Regarding claims 11 and 12, both de la Torre and Mulhauser et al. teach of prosthetic meshes with ridges, however they lack the teaching of multiple ridges and different ridge formations. Kugel teaches of two concentric ring shaped ridges. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of de la Torre to have ridges in the shape of concentric rings or other designs to provide sufficient stiffness and strength for the mesh material.

Kugel (USPN D416,327) does not expressly disclose the limitations of claim 13. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kugel to include ridges of a different shape because Applicant has not disclosed that the varying shapes of ridges provides an advantage, is used for a particular problem, or solves a stated problem. One of ordinary skill in the art, furthermore,

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would have expected Applicant's invention to perform equally well with a concentric ring shaped ridges because it provides sufficient stiffness and strength to keep the mesh in the preferred flat shape.

Therefore, it would have been an obvious matter of design choice to modify the invention of Kugel to obtain the invention as specified in claim 13.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal M Gilpin whose telephone number is 703-305-8122. The examiner can normally be reached on M-F, 7:30-5:30 (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9301 for regular communications and 703-872-9301 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

cmg
December 12, 2002


Paul B. Prebilic
Primary Examiner